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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,196	01/17/2002	R. Eric Montgomery	04163-00138	6812

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EXAMINER

ROSE, SHEP K

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 03/18/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10 050196

Applicant(s)

MONTGOMERY

Examiner

STEP ROSE

Group Art Unit

1614

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on Feb 10 2003
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 & 63 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☒ Other _____

Office Action Summary

Art Unit: 1614

The reply filed on Feb 10, 2003 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): the amendment is objected to, for naming applicant, who signed the oath (in 10/039,935) as Robert Eric Montgomery (full name of inventor) Robert E. Montgomery, but ^{herein} signed as "R. Eric Montgomery", and since the USPTO Examiner has been tasked to conduct, and to update, an investigation into the issue of obviousness-type double patenting of a named applicants; material, relevant and important copending claims and patents, and the only tool the USPTO Examiner has is an Inventor name search, for last name and first name. There are many entries for Montgomery, Robert in the Inventor name search, and many entries for Montgomery, Eric, and this applicant has entries in both (depending on how the oath was signed) that seem pertinent, (some are in as "Montgomery, Eric R.", others in "Montgomery, Robert E.") and (there is another Montgomery, R.E. active in this area) some titles seem to be pertinent, and seem to be this applicant's. Which copending case claims and patents are material, relevant and important to the issue of double Patenting and patentability of examined claims 13 to 48? Which copending and / or ancestor applications enable a rinse as in of record claims 15, 20, 26, 31, 34, 37, 40, and especially claims 43 to 47, sequentially followed by brushing with a peroxide dentifrice or paste or gel ?, and newly presented claims 51, 56, 59, 62 and 63? (Copies of such claims of applicants are requested). Is any of this explicitly described in the written description/enabement of provisional application serial no. 60/004,258 filed September 25, 1995(as implied in the remarks)? A copy is requested herewith!!

At what point in time did the public have a right to inspect and make copies of priority document?

The first U.S. patent 5922307 which issued July 13, 1999, which has no claim ever presented 6312670 to any rinse, dentifrice, gel, or paste, and no claim 6322773 ever presented to any sequential method of first applying to teeth, for whitening, an alkaline PH 8.0 to 10.5, aqueous rinse, thereafter immediately followed by brushing with a peroxide dentifrice, without water rinsing the teeth between the rinse regime and the dentifrice regime, as claimed by Curtis et al U.S. 6174516, claims 1 to 6 which issued January 16, 2001? Applicant presented such patented claims as claims 43 to 48 herein January 16, 2002 with the remarks that "the above claims 43 to 48 are "hereby copied within 1 year of issuance", to "preserve rights under 35 USC 135." Such "rights might arise if there is herein, and in each and every ancestor applications and the priority document (hereby requested) a written description enablement of claims 43 to 48 and continuous pending claims to the same subject matter.

There may be an issue of 35 USC 102 (C) invention if the hereby requested priority document (repeatedly argued in remarks) does (surprisingly) has a written description enablement of claims 43 to 48, one left out of the chain of ancestor applications, (now patents).

The administrative law judges of the USPTO make the determination (not the primary Examiner) as to whether or not claims 43 to 48 have basis herein to provoke an interference with U.S. 6174516.

The amendments to the specification are objected to as new matter.

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See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shep Rose whose telephone number is (703) 308-4609. The examiner can normally be reached on Monday, Tuesday, and Thursday 7:30am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Rose/tgd
March 17, 2003


SHEP K. ROSE
PRIMARY EXAMINER

SHEP K. ROSE
PRIMARY EXAMINER